

REMARKS

Claims 1-28 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Fontanesi et al.* (U.S. 6,681,323) in view of *van Gilluwe et al.* (U.S. 6,351,850). Applicants traverse this rejection on the grounds that these references are defective in establishing a *prima facie* case of obviousness.

As the PTO recognizes in MPEP § 2142:

...The Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the Examiner does not produce a *prima facie* case, the Applicant is under no obligation to submit evidence of nonobviousness....the Examiner must step backward in time and into the shoes worn by the hypothetical 'person of ordinary skill in the art' when the invention was unknown and just before it was made....The Examiner must put aside knowledge of the Applicant's disclosure, refrain from using hindsight, and consider the subject matter claimed 'as a whole.'"

Amended independent claims 1, 10, and 19 now include:

"in response to a size of a storage device, identifying a sector offset on the storage device;

storing an image onto the storage device at the sector offset, the image including an operating system."

Amended independent claim 28 now includes:

"in response to a size of a storage device, identifying a sector offset on the storage device;

storing an image onto the storage device at the sector offset, the

image including an operating system;
providing the sector offset to an installation engine by storing the
sector offset in a predetermined location on the storage device.”

It is respectfully submitted that the examiner cannot factually support
a *prima facie* case of obviousness for the following mutually exclusive
reasons.

**1. Even when combined, the references do not teach the
claimed subject matter**

The *Fontanesi* and *van Gilluwe* patents cannot be applied to reject
claim 1 under 35 U.S.C. §103, which provides that:

A patent may not be obtained ... if the difference between the
subject matter sought to be patented and the prior art are such that
the subject matter as a whole would have been obvious at the time
the invention was made to a person having ordinary skill in the art to
which the subject matter pertains... (Emphasis added).

Thus, when evaluating a claim to determine whether it is obvious, all
limitations of the claim must be evaluated. However, the combination of the
Fotanesi and *van Gilluwe* patents does not teach the following elements of amended
independent claim 1: “in response to a size of a storage device, identifying a sector
offset on the storage device; storing an image onto the storage device at the sector
offset, the image including an operating system” (Emphasis added). More
specifically, the combination of the *Fotanesi* and *van Gilluwe* patents does not teach
identifying a sector offset on a storage device in response a size of the storage
device, and subsequently storing an image onto the storage device at the same
sector offset that was identified in response to the size of the storage device.

Because the combination of the *Fotanesi* and *van Gilluwe* patents does not teach all of the elements recited in amended independent claim 1, the rejection of claim 1 under obviousness is improper. Also, rejections under obviousness of independent claims 10, 19, and 28 are improper for substantially the same reason discussed above. Accordingly, it is respectfully requested that the rejections of claims 1, 10, 19, and 28 under 35 U.S.C. §103(a) be withdrawn. Moreover, dependent claims 2,3, 5-9, 11, 12, 14-18, 20, 21, and 23-27 depend from and further limit the allowable subject matter claimed in the independent claims, and therefore are allowable as well.

2. The combination of the references is improper

The Federal Circuit has, on many occasions, held that there was no basis for combining references to support a 35 U.S.C. §103 rejection. For example, in *In re Geiger*, the court stated in holding that the PTO “failed to establish a *prima facie* case of obviousness”:

Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination. *ACS Hospital Systems, Inc. v. Monteffiore Hospital*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984).

The Federal Circuit has also repeatedly warned against using the applicant’s disclosure as a blueprint to reconstruct the claimed invention out of isolated teachings in the prior art. See, e.g., *Grain Processing Corp. v. American Maize-Products*, 840 F.2d 902, 907, 5 USPQ2d 1798, 1792 (Fed. Cir. 1989).

More recently, the Federal Circuit found motivation absent in *In re Rouffet*, 149 F.3d 1350, 47 USPQ2d 1453 (Fed. Cir. 1998). In this case, the court concluded that the board had “reversibly erred in determining that one of [ordinary] skill in the

art would have been motivated to combine these references in a manner that rendered the claimed invention [to have been] obvious.” The court noted that to “prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the examiner to show a motivation to combine the references that create the case of obviousness.” The court further noted that there were three possible sources for such motivation, namely “(1) the nature of the problem to be solved; (2) the teachings of the prior art; and (3) the knowledge of persons of ordinary skill in the art.” Here, according to the court, the board had relied simply upon “the high level of skill in the art to provide the necessary motivation,” without explaining what specific understanding or technological principle within the knowledge of one of ordinary skill in the art would have suggested the combination. Notably, the court wrote: “If such a rote invocation could suffice to supply a motivation to combine, the more sophisticated scientific fields would rarely, if ever, experience a patentable technical advance.”

Therefore, there is simply no basis in the art for combining the references to support a 35 U.S.C. §103 rejection since neither *Fontanesi et al.* patent nor the *van Gilluwe et al.* patent teaches or even suggests the desirability of the combination. Moreover, neither patent provides any incentive or motivation supporting the desirability of the combination.

The MPEP §2143.01 provides:

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).


Therefore, the Examiner's combination arises solely from hindsight based on the invention without any showing of suggestion, incentive or motivation in either reference for the combination.

Thus, the Examiner's burden of factually supporting a *prima facie* case of obviousness has clearly not been met. Accordingly, it is respectfully submitted that independent claims 1, 10, 19, and 28 and their dependent claims are allowable.

Conclusion

In view of the above, it is respectfully submitted that claims 1-3, 5-12, 14-21, and 23-28 are in condition for allowance. Accordingly, an early Notice of Allowance is courteously solicited.

Respectfully submitted,


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A-165156_1.DOC

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